

REMARKS

Claim 14 is rejected under 35 U.S.C. 112 as being indefinite for depending from a canceled claim. This rejection is overcome in view of the amendment to claim 14.

Claims 1, 4, 12-16 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Dharnipragada* (U.S. 6,490,493) in view of *Kroening et al.* (U.S. 6,080,207), further in view of *Knowles et al.* (U.S. 6,182,897). This rejection is respectfully traversed for the reasons set forth below. The rejection generalizes the application of the cited art to the specific language of the claims.

Claim 1 includes: the control unit detecting any modification details in the main order details and obtaining corresponding configuration details from the modification unit; the control unit checking the configuration details with a factory database for implementation; and the control unit entering appropriate data into the computer being manufactured including entering modification details in appropriate ones of the selected software components which are being installed or have been installed in the computer.

As the PTO recognizes in MPEP §2142:

...The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a prima facie case of obviousness in connection with claims 1, 4, 12-16 and 19 for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach the control unit detecting any modification details in the main order details and obtaining corresponding

configuration details from the modification unit; the control unit checking the configuration details with a factory database for implementation; and the control unit entering appropriate data into the computer being manufactured including entering modification details in appropriate ones of the selected software components which are being installed or have been installed in the computer.

Therefore, it is impossible to render the subject matter of claims 1, 4, 12-16 and 19 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to these claims and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject claims 1, 4, 12-16 and 19 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person or ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing the control unit detecting any modification details in the main order details and obtaining corresponding configuration details from the modification unit; the control unit checking the configuration details with a factory database for implementation; and the control unit entering appropriate data into the computer being manufactured including entering modification details in appropriate ones of the selected software components which are being installed or have been installed in the computer.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for the combining the references to support a 35 U.S.C. §103(a) rejection of claims 1, 4, 12-16 and 19.

In this context, the MPEP further provides at §2143.01:

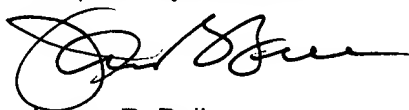
The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original).

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to the claims and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of all of the above, the allowance of claims 1, 4, 12-16 and 19 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,




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Dated:

3-17-06

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on	Mar 17, 2006
Date	
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